

that “[c]laims 8-17 are nothing more than a vague collection of ideas with no definite steps” and that “[o]ne of ordinary skill in the art could not determine the meters [sic] or boards [sic] of these ‘method’ claims.” Final Office Action at p. 2.

The second paragraph of 35 U.S.C. § 112 merely requires that “the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” M.P.E.P. § 2173.02 (emphasis added). Moreover, the “focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” *Id.* Indeed, “[s]ome latitude in the manner of expression and the aptness of terms should be permitted,” and “Examiners . . . should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.” *Id.*

As more fully set forth in the Amendment filed on August 21, 2002 it is respectfully submitted that claims 8 to 17 fully comply with the requirements of 35 U.S.C. § 112. In this regard, the Examiner’s attention is directed to, for example, claim 8, line 2, which recites that “a definition is made,” which is a method step. The Examiner’s attention is further directed to, for example, claim 12, line 2, which recites that a “control unit (D) determines that correction factor,” which is also a method step. Moreover, claim 13 recites that “the control unit determines the correction factor,” claim 14 recites that “the normal travel distance and the respective actual travel distance are measured,” claim 15 recites that “the correction factor is measured,” and claim 16 recites that “the correction factor is stored.” All of the foregoing limitations are method steps and do not constitute a “vague collection of ideas with no definitive steps” as alleged in the Final Office Action. It is therefore respectfully submitted that claims 8 to 17 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

### **III. Rejection of Claims 1, 3, 4, 18, 20, 21, and 25 Under 35 U.S.C. § 102(a)**

Claims 1, 3, 4, 18, 20, 21, and 25 were rejected under 35 U.S.C. § 102(a) as anticipated by Japanese Published Patent Application No. 7-107753 (“Hirotsada et al.”) or Japanese Published Patent Application No. 63-167684 (“Katsuhiro et al.”). Applicants respectfully submit that neither Hirotsada et al. nor Katsuhiro et al. anticipates the present claims for the following reasons.

Claim 1 relates to an apparatus for charging a piezoelectric element. Claim 1 recites that an activation voltage and an activation charge value for driving the piezoelectric element is controlled online by a control unit which adjusts the activation voltage and activation charge values in order to compensate for deviations caused by variations in the piezoelectric element layer thickness or the number of layers.

Claim 18 relates to an apparatus for charging a piezoelectric element and recites that the apparatus includes a control unit configured to control an activation voltage and an activation charge value to drive the piezoelectric element, the control unit configured to adjust the activation voltage and activation charge value to compensate for a deviation caused by a variation of at least one of a layer thickness of the piezoelectric element and a number of layers of the piezoelectric element.

Claim 25 relates to a method for charging a piezoelectric element and recites that the method includes defining, prior to charging, a value for an activation voltage and a value for an activation charge of the piezoelectric element as a function of a batch variation in a travel of the piezoelectric element.

Hirotsada et al. purport to relate to a piezoelectric-element driving device, and Katsuhiro et al. purport to relate to a control circuit for a piezoelectric actuator. In support of the present rejection, the Final Office Action states:

Claims 1, 3, 4, 18, 20, 21 and 25 are rejected under 35 U.S.C. 102 as anticipated by [Hirotsada et al.] or [Katsuhiro et al.]. It is noted that these references were also applied as anticipatory references by the European Search Authority in the Search Report submitted by applicants on 7-9-01. (See the English language abstract) a control circuit for driving a piezo-electric element while compensating for changes caused by ageing, temperature, etc. etc. [sic] Any defect or abnormality would be compensated, including those perceived to originate in the manufacturing process. Thus without specific mention of changes in thickness due to e.g. manufacturing defects, these references inherently compensate for such variations [sic] by the apparatus and method as disclosed. Note claim [sic] 18 and 1 merely call for apparatus "characterized" or "configured" to perform a desired function. Structurally they only define a piezo-electric actuator and any drive circuit. These narrative type claims, not using "means plus function" language thus would not define from the references even if the references didn't show the desired function noted in applicants [sic] claims. (Emphasis in original).

As an initial matter, whether certain patents or printed publications were cited in the search report submitted on July 6, 2001 not relevant to the patentability of the present claims of the instant application.

While the Final Office Action appears to be referring to the English-language abstract of only one of Hirotsada et al. and Katsuhiro et al., no clarification is made as to which, if any, is being relied on in the Final Office Action. Furthermore, neither Hirotsada et al. nor Katsuhiro et al. provides a description in which any possible defect or abnormality is compensated for, including those perceived to originate in the manufacturing process, and neither describes compensating for aging of the piezoelectric element, as alleged in the Final Office Action. Section 2131.01 of the M.P.E.P. provides that only one reference should be used to make a rejection under 35 U.S.C. § 102, unless a second reference is necessary to prove the primary reference contains an enabled disclosure, explain the meaning of a term used in the primary reference, or show that a characteristic not disclosed in the reference is inherent. The Final Office Action does not note any such intended use of either reference. Therefore, it is respectfully requested that the Examiner properly explain the basis for this rejection on these two references as required by 35 U.S.C. § 102, or withdraw the rejection.

To the extent that the rejection is understood, the Examiner is maintaining that even if the references fail to describe features recited in the rejected claims, such as compensating for deviations caused by variations in the piezoelectric element's layer thickness or the number of layers, "these references inherently compensate for such [variations]," as recited by the rejected claims.

As an initial matter, it is "well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office." Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). Furthermore, "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, supra, 17 U.S.P.Q.2d at 1461, 1462 (Bd. Pat. App. & Inter. 1990). It is respectfully submitted that the conclusory statements that "without specific mention of changes in thickness," and "even if the references didn't show the desired function noted in [the rejected claims]," these references "inherently" include such features, fails to establish a prima facie case of anticipation of claims 1, 3, 4, 18, 20, 21, and 25. It is

therefore respectfully submitted that this rejection should be withdrawn for this reason alone.

Moreover, it is respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. discloses, or even suggests, an apparatus for charging a piezoelectric element in which an activation voltage and an activation charge value for driving the piezoelectric element is controlled online by a control unit which adjusts the activation voltage and activation charge values in order to compensate for deviations caused by variations in the piezoelectric element's layer thickness or the number of layers as recited in claim 1. In addition, it is respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. discloses, or even suggests, a control unit configured to control an activation voltage and an activation charge value to drive the piezoelectric element, the control unit configured to adjust the activation voltage and activation charge value to compensate for a deviation caused by a variation of at least one of a layer thickness of the piezoelectric element and a number of layers of the piezoelectric element. Furthermore, it is respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. discloses, or even suggests, a method for charging a piezoelectric element in which a definition is made, prior to charging, a value for an activation voltage and a value for an activation charge of the piezoelectric element as a function of a batch variation in a travel of the piezoelectric element, as in claim 25.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. discloses, or even suggests, all of the limitations of claims 1, 18 and 25. It is therefore respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. anticipates claims 1, 18 and 25.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18

U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the references relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, supra, 17 U.S.P.Q.2d 1461 at 1464. Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. anticipates claims 1, 18 and 25.

As for claims 3 and 4, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1, and claims 20 and 21, which ultimately depend from claim 18 and therefore include all of the limitations of claim 18, it is respectfully submitted that neither Hirotada et al. nor Katsuhiro et al. anticipates these dependent claims for at least the same reasons given above in support of the patentability of claims 1 and 18.

#### **IV. Rejection of Claims 1, 2, 8, 9, 18, 19, 25, and 26 Under 35 U.S.C. § 102(a)**

Claims 1, 2, 8, 9, 18, 19, 25, and 26 were rejected under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 4,593,658 ("Moloney"). Applicants respectfully submit that Moloney does not anticipate the present claims for the following reasons.

Claim 1 relates to an apparatus for charging a piezoelectric element. Claim 1 recites that an activation voltage and an activation charge value for driving the piezoelectric element is controlled online by a control unit which adjusts the activation voltage and activation charge values in order to compensate for deviations



caused by variations in the piezoelectric element layer thickness or the number of layers.

Claim 8 relates to a method for charging a piezoelectric element and recites that a definition is made, prior to charging, as to a value for an activation voltage and a value for an activation charge of the piezoelectric element as a function of batch variation in the travel of the piezoelectric element.

Claim 18 relates to an apparatus for charging a piezoelectric element and recites that the apparatus includes a control unit configured to control an activation voltage and an activation charge value to drive the piezoelectric element, the control unit configured to adjust the activation voltage and activation charge value to compensate for a deviation caused by a variation of at least one of a layer thickness of the piezoelectric element and a number of layers of the piezoelectric element.

Claim 25 recites a method for charging a piezoelectric element, including the step of defining, prior to charging, a value for an activation voltage and a value for an activation charge of the piezoelectric element as a function of a batch variation in a travel of the piezoelectric element.

Moloney purports to relate to a valve operating mechanism for internal combustion and like valved engines. In support of the present rejection, the Final Office Action states that:

Moloney teaches providing a feedback loop to control the charging of a piezo injector. Travel distance is measured and compensated for if it isn't equal to a desired value [sic] this on-line compensation is constant as conditions change e.g. were, temperature flection [sic] etc. Thus any abnormalities of piezo expansion and contraction requiring compensation are addressed and corrected.

Office Action at p. 3.

However, as more fully set forth above, it is respectfully submitted that such conclusory statements fail to establish a prima facie case of anticipation, for which the Office carries the burden of proof. It is therefore respectfully submitted that this rejection should be withdrawn for this reason alone.

Moreover, it is respectfully submitted that Moloney does not disclose, or even suggest, an apparatus for charging a piezoelectric element in which an activation voltage and an activation charge value for driving the piezoelectric

element is controlled online by a control unit which adjusts the activation voltage and activation charge values in order to compensate for deviations caused by variations in the piezoelectric element's layer thickness or the number of layers as recited in claim 1. In addition, it is respectfully submitted that Moloney does not disclose, or even suggest, a method for charging a piezoelectric element in which a definition is made, prior to charging, as to a value for an activation voltage and a value for an activation charge of the piezoelectric element as a function of batch variation in the travel of the piezoelectric element as recited in claim 8. It is also respectfully submitted that Moloney does not disclose, or even suggest, an apparatus for charging a piezoelectric element that includes a control unit configured to control an activation voltage and an activation charge value to drive the piezoelectric element, the control unit configured to adjust the activation voltage and activation charge value to compensate for a deviation caused by a variation of at least one of a layer thickness of the piezoelectric element and a number of layers of the piezoelectric element as recited in claim 18. Furthermore, it is respectfully submitted that Moloney does not disclose, or even suggest, a method for charging a piezoelectric element, including the step of defining, prior to charging, a value for an activation voltage and a value for an activation charge of the piezoelectric element as a function of a batch variation in a travel of the piezoelectric element as in claim 25.

In view of all of the foregoing, it is respectfully submitted that Moloney does not anticipate claims 1, 8, 18 and 25.

As for claim 2, which depends from claim 1 and therefore includes all of the limitations of claim 1, claim 9, which depends from claim 8 and therefore includes all of the limitations of claim 8, claim 19, which depends from claim 18 and therefore includes all of the limitations of claim 18, and claim 26, which depends from claim 25 and therefore includes all of the limitations of claim 25, it is respectfully submitted that Moloney does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claims 1, 8, 18 and 25.

**V. Rejection of Claims 3 to 7, 10 to 14, 20 to 24, 30 and 31 Under 35 U.S.C. § 103(a)**

Claims 3 to 7, 10 to 14, 20 to 24, 30 and 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over Moloney in view of U.S. Patent No. 5,384,507

("Takada et al.") or U.S. Patent No. 6,340,858 ("Jaenker"). Applicants respectfully submit that the combination of Moloney and Takada et al. or Jaenker does not anticipate the present claims for the following reasons.

As an initial matter the Final Office Action states that "[c]laims 3-7, 10-14, 20-24 and 10-31 are rejected under 35 U.S.C. 103 as unpatentable over Moloney in view of Takada or Jaenker for the explicit reasons set forth in paper no 6 (3-37-02) [sic]." Final Office Action at page 3. It is believed that "10-31" is a typographic error and that what was meant was "30-31."

Claims 3 to 7 ultimately depend from claim 1 and therefore include all of the limitations of claim 1, claims 10 to 14 ultimately depend from claim 8 and therefore include all of the limitations of claim 8, claims 20 to 24 ultimately depend from claim 18 and therefore include all of the limitations of claim 18, and claims 30 and 31 depend from claim 25 and therefore include all of the limitations of claim 25. As more fully set forth above with respect to claims 1, 8, 18 and 25, Moloney does not disclose, or even suggest, all of the limitations of claims 1, 8, 18 and 25. Takada et al. and Jaenker are not relied on for disclosing or suggesting the limitations of claims 1, 8, 18 and 25 not disclosed or suggested by Moloney. Indeed, it is respectfully submitted that neither Takada et al. nor Jaenker discloses, or even suggests, the limitations of claims 1, 8, 18 and 25 not disclosed or suggested by Moloney.

The Office Action of March 27, 2002 includes a rejection of claims "3-7 and 10-14" under 35 U.S.C. § 103(a) as unpatentable over "Moloney or Mitsuyasu in view of Takada or Jaenker." Regarding Moloney, the Office Action of March 27, 2002 states that "Moloney and Mitsuyasu teach compensating a stack of piezoelectric elements in a fuel injector for travel distance based on variation, between actual and ideal conditions," but provides no support for such assertion. The present rejection is based on only Moloney in view of Takada and Jaenker. Neither the present Final Office Action nor the Office Action of March 27, 2002 specifies which features of which claims are asserted as disclosed by Moloney, as opposed to those allegedly disclosed by Mitsuyasu which is no longer relied upon, to form the basis for this rejection. Furthermore, no grounds are provided in either Office Action on which to base the rejection of claims 30 and 31. It is respectfully requested that the rejection be withdrawn, or restated following the guidelines provided in M.P.E.P. § 706.02(j).



These guidelines provide that when indicating a rejection under 103, the Examiner should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P. § 706.2(j).

The Office Action of March 27, 2002 further contends that "Takada [et al.] and Jaenker teach measuring the relationship between voltage and displacement and thus obtaining a correction factor" but provides no support for this assertion. The Office Action of March 27, 2002 contends that "[i]t would have been obvious to one of ordinary skill in the art [sic] to select from among known compensation techniques and thus to use voltage factors in the devices of Moloney or Mitsuyasu."

As an initial matter, obviousness must be determined with reference to that which would have been obvious to one of ordinary skill in the art at the time the invention was made. Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 218 U.S.P.Q. 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). None of the Office Actions to date even allege that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify or combine the cited references. Indeed, the Office Action of March 27, 2002 merely alleges that "[i]t would have been obvious to one of ordinary skill in the art [sic] to select from among known compensation techniques and thus to use voltage factors in the devices of Moloney or Mitsuyasu." Office Action of March 27, 2002 at p. 3. It is therefore respectfully submitted that this rejection should be withdrawn for this reason alone.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837

F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, it is respectfully submitted that Moloney does not disclose, or even suggest, all of the limitations of claim 1, from which claims 3 to 7 ultimately depend, claim 8, from which claims 10 to 14 ultimately depend, claim 18, from which claims 20 to 24 ultimately depend and claim 25, from which claims 30 and 31 ultimately depend, and it is respectfully submitted that neither Takada et al. nor Jaenker discloses, or even suggests, the limitations of claims 1, 8, 18 and 25 not disclosed or suggested by Moloney. It is therefore respectfully submitted that the combination of Moloney and Takada et al. or Jaenker does not render obvious dependent claims 3 to 7, 10 to 14, 20 to 24, 30 and 31.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to

combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 3 to 7, 10 to 14, 20 to 24, and 30 to 31. It is therefore respectfully submitted that claims 3 to 7, 10 to 14, 20 to 24, and 30 to 31 are allowable for these reasons.

**VI. Rejection of Claims 15 to 17 and 32 to 34 Under 35 U.S.C. § 103(a)**

Claims 15 to 17 and 32 to 34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Moloney in view of Takada et al. or Jaenker and further in view of U.S. Patent No. 5,575,264 ("Barron") or U.S. Patent No. 6,247,451 ("Estevenon et al."). Applicants respectfully submit that the combination of Moloney and Takada et al. or Jaenker and Barron or Estevenon et al. does not render obvious the present claims for the following reasons.

Claims 15 to 17 ultimately depend from claim 8 and therefore include all of the features and limitations of claim 8, and claims 32 to 34 ultimately depend from claim 25 and therefore include all of the features and limitations of claim 25. As more fully set forth above with respect to claims 8 and 25, Moloney does not disclose, or even suggest, all of the limitations of claims 8 and 25. As more fully set forth above with respect to claims 8 and 25, the combination of Moloney and Takada et al. or Jaenker does not disclose, or even suggest, all of the limitations of claims 8 and 25. Neither Barron nor Estevenon et al. is relied on for disclosing or suggesting the limitations of claims 8 and 25 not disclosed or suggested by Moloney, Takada et al. or Jaenker. Indeed, it is respectfully submitted that neither Barron nor Estevenon et al. discloses, or even suggests, the limitations of claims 8 and 25 not disclosed or suggested by Moloney, Takada et al. or Jaenker.

Moreover, it is again respectfully submitted that U.S. Patent No. 6,247,451 does not constitute prior art against the present application. The present application was filed on April 2, 2001 and claims priority to European Patent

Application No. 00106990.5, filed on April 1, 2000. U.S. Patent No. 6,247,451 issued on June 19, 2001 from a U.S. national stage application filed under 35 U.S.C. § 371. Accordingly, U.S. Patent No. 6,247,451 does not constitute prior art against the present application. See M.P.E.P. §§ 706.02(a) and 2136.03.

The Office Action states at page 3, "regarding applicant's comments it is noted that U.S. Patent 6247451 has a 35 U.S.C. 102(c) [*sic*] date of 12/18/99 and was published as WO 9a/43940 [*sic*] on 9-2-99 which is substantially prior to applicant's claimed priority date of 4/1/00." However as provided by M.P.E.P. § 2136.03:

Note that when examining a PG-PUB application, any **patent** issued from a national stage application would have no prior art date under 35 U.S.C. 102(e). (Emphasis in original).

Applicants further note that International Published Patent Application No. WO 99/43940 has not been made of record in the present application. To the extent that the rejection is based on International Published Patent Application No. WO 99/43940, Applicants respectfully request proper citation of this publication and respectfully request that the period of reply be restarted.

In view of all of the foregoing, it is respectfully submitted that the combination of Moloney and Takada et al. or Jaenker and Barron or Estevenon et al. does not render obvious claims 15 to 17 and 32 to 34. Withdrawal of this rejection is therefore respectfully requested.



**VII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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